

REMARKS

Claims 1 to 28 are all the claims pending in the application, prior to the present amendment.

The Examiner states that the amendment to the claims filed on October 29, 2007 contains an incorrect status modifier for claim 1. The Examiner states that the correct status modifier should be “(withdrawn)” and not “(original).”

In response, applicants have corrected the status modifier in the above listing of claims.

The Examiner states that applicants cannot obtain benefit of the provisional application 60/443,529 because it is in Japanese and there is no English translation of the provisional application and no statement that the translation is accurate in the provisional application.

Applicants disagree with the Examiner’s statement that an English translation with an appropriate statement was not filed. Applicants enclose a copy of a stamped filing receipt in the provisional application showing that the translation and translator’s declaration were filed on January 23, 2004.

In addition, applicants have today filed another copy of the translation and translator’s declaration in the provisional application.

Claim 5 has been rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirements.

The Examiner points out that claim 5 as amended recites that powder B is an “organic oxide,” but that there is no description in the specification of “an organic oxide.”

Amended claim 5 contained a typographical error. Applicants have now amended claim 5 to correct the typographical error by reciting an “inorganic oxide powder B.”

In view of this amendment, applicants request withdrawal of this rejection.

Claims 5, 7, 9 and 10 have been rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

The Examiner states that it is unclear when the claimed step of spraying powder A and powder B into the flame occurs. The Examiner states it is unclear whether this step occurs during the “bring step” of claim 2, or the “second bringing” step of claim 2, or during “both bring steps” of claim 2.

In addition, the Examiner states that claims 7, 9 and 10 are indefinite because it is unclear when powder B is brought into the flame during the process of claim 2.

Finally, the Examiner states that claims 5 and 7 are indefinite because it is unclear which flame in claim 2 the phrase “the flame” refers to. The Examiner questions whether “the flame” in claims 5 and 7 refers to the flame in the first step of claim 2, or the flame in the second step of claim 2, or the flame in both steps of claim 23.

In response, applicants point out that the claimed step of spraying powder A and powder B in claim 5 occurs during the first bringing step of claim 2. In addition, powder B is brought into the flame during the first step of claim 2.

In order to further clarify these points, applicants have amended claims 2, 5, and 7 as set forth above.

In view of these amendments, applicants request withdrawal of this rejection.

Claims 2 and 3 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 5,140,005 to Rangaswamy et al.

The Examiner sets forth a detailed statement of this rejection beginning at the bottom of page 4 of the Office Action.

Applicants note that the Examiner also states at page 6 of the Office Action that claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the recitations of the base claims and any intervening claim. The Examiner states that the process of claim 8 of passing a substantially spherical powder composed of an oxide of Al, Mg, Ca, Ti, Si and mixtures thereof through a high-temperature flame and then repeating this process is not taught or suggested by the cited prior art.

In a second rejection of the claims under 35 U.S.C. § 103 as being unpatentable over Lange et al and Oda et al, the Examiner refers to claim 8 and states that the taught spherical aluminum particles of the prior art teach claim 8 since spherical particles, by definition, must have a spherical degree of about 1. Since the Examiner included claim 8 in the discussion of the rejection of claims 2-7, 9 and 10, it was not clear to undersigned counsel whether the Examiner had, in fact, intended to indicate that claim 8 was allowable. Accordingly, undersigned counsel called the Examiner for clarification.

During the telephone conference of January 18, 2008, as set forth in an Interview Summary that the Examiner sent to undersigned counsel by facsimile, the Examiner clarified that the statement about claim 8 in the rejection was in error. The Examiner stated that she had, in fact, intended to indicate that claim 8 was allowable.

In view of the Examiner's indication that claim 8 is allowable, applicants have amended claim 2 to include the recitations of claim 8, including the recitations of claim 6 from which claim 8 depends. In view of these amendments, applicants have canceled claims 6 and 8.

In view of the above, applicants request withdrawal of this rejection.

Claims 2-7, 9 and 10 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 6,468,658 to Lange et al in view of U.S. Patent 5,340,781 to Oda et al.

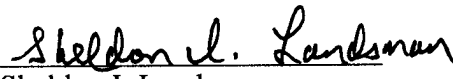
As discussed above, applicants have incorporated the subject matter of claim 8 into claim 2. Claim 8 was not included in this rejection and has been indicated to be allowable.

In view of the above, applicants request withdrawal of this rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 10, 2008

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FILING RECEIPT
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In re application of

Hisao KOGOI, et al.

Appln. No.: 60/433,529

Group Art Unit: not yet assigned

Confirmation No.: not yet assigned

Examiner: not yet assigned

Filed: January 23, 2004

For: SURFACE MODIFICATION METHOD OF INORGANIC OXIDE POWDER, POWDER
PRODUCED BY THE METHOD AND USE OF THE POWDER

PAPER(S) FILED ENTITLED:

1. Submission of Verified English Language Translation, forty-five (45) pages of specification, translator's Declaration and six (6) sheets of drawings.

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DOCKET NO.: P74015
ATTORNEY/SEC: SIL/dmg
Date Filed: January 23, 2004

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

